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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,279	03/25/2004	Wataru Asano	251116US2SRD	5106
22850	7590	03/28/2008	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			LU, TOM Y	
			ART UNIT	PAPER NUMBER
			2624	
			NOTIFICATION DATE	DELIVERY MODE
			03/28/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/808,279	<b>Applicant(s)</b> ASANO ET AL.	
	<b>Examiner</b> Tom Y. Lu	<b>Art Unit</b> 2624	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03/25/2004; 11/23/2005; 11/28/2006; 12/20/2006</u> .          | 6) <input type="checkbox"/> Other: ____.                          |



## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement (IDS) submitted on 03/25/2004 has been considered by the examiner.
2. The information disclosure statement (IDS) submitted on 11/23/2005 has been considered by the examiner.
3. The information disclosure statement (IDS) submitted on 11/28/2006 has been considered by the examiner.
4. The information disclosure statement (IDS) submitted on 12/20/2006 has been considered by the examiner.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Cox et al (“Cox” hereinafter) (U.S. Patent No. 5,930,369).
  - a. As per claim 1, Cox discloses a digital watermark detection method of detecting watermark information embedded in an input image signal, comprising: reducing an image size of the input image signal to generate a size-reduced image signal; and detecting the watermark information in the size-reduced image signal (column 12, lines 55-61).

b. As per claim 2, see explanation in claim 1.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 1 are rejected under 35 U.S.C. 102(a) as being anticipated by Yamakage et al (“Yamakage” hereinafter) (U.S. Patent Publication No. 2003/0091213 A1).

a. As per claim 1, Yamakage discloses a digital watermark detection method of detecting watermark information embedded in an input image signal, comprising: reducing an image size of the input image signal to generate a size-reduced image signal; and detecting the watermark information in the size-reduced image signal (paragraph [0021, cut-out and scaling are both considered as size-reduced, and detecting embedded watermark from the size-reduced image signal]).

b. As per claim 2, see explanation in claim 1.

c. As per claim 3, see figure 4.

d. As per claim 4, see figure 5.

e. As per claim 12, see paragraphs [0107]-[0110].

f. As per claim 24, the recitation “a digital watermark detection ... the size reduced image signal” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). The

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limitations recited in the body of the claim are rejected for the same reason given in claim 3.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 2, 5-11, 13-23 and 25-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Asano et al (“Asano” hereinafter) (U.S. Patent No. 7,284,130 B2)

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

- a. As per claim 1, Asano discloses a digital watermark detection method of detecting watermark information embedded in an input image signal, comprising: reducing an image size of the input image signal to generate a size-reduced image signal; and detecting the watermark information in the size-reduced image signal (column 2, lines 41-46).
- b. As per claim 2, see explanation in claim 1.
- c. As per claim 5, see column 2, lines 59-67.
- d. As per claim 6, see controller in figure 4.
- e. As per claim 7, scaling at column 2, line 45 includes down-sampling pixel values.
- f. As per claim 8, see column 5, line 65.

- g. As per claim 9, see column 3, lines 1-15.
- h. As per claim 10, see figure 4.
- i. As per claim 11, see explanation in claim 7.
- j. As per claim 13, see numeral 25 in figure 6.
- k. As per claim 14, see explanation in claim 13.
- l. As per claim 15, see figure 6.
- m. As per claim 16, see figure 6.
- n. As per claim 17, see figure 7.
- o. As per claim 18, see figure 8.
- p. As per claim 19, see figure 9.
- q. As per claim 20, see figure 10.
- r. As per claim 21, see figure 13.
- s. As per claim 22, scaling ratio is the claimed reduction ratio.
- t. As per claim 23, scaling includes resolution reduction.
- u. As per claim 25, see explanation in claim 5.
- v. As per claim 26, see explanation in claim 9.
- w. As per claim 27, conversion from a high definition image signal to a standard definition image signal is a down scaling.

### ***Conclusion***

9. **Examiner note:** Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teaching for the art and are applied to the specific

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limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potential teaching all or part of the claimed invention, as well as the context of the a passage as taught by the prior art or disclosed by the examiner.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom Y. Lu whose telephone number is (571) 272-7393. The examiner can normally be reached on 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Bella can be reached on (571)-272-7778. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Tom Y Lu/

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